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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,316	01/18/2002	Alfred Thomas	2100/17	8018
7590	12/01/2004		EXAMINER	
Michael H. Baniak BANIAK PINE & GANNON 150 N. Wacker Drive, Suite 1200 Chicago, IL 60201			MOSSER, ROBERT E	
		ART UNIT	PAPER NUMBER	
		3714		

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/051,316	THOMAS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 July 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1, 3-47, 49-80, 82-103, and 112-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 112 and 113 is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) 13,23-35,56 and 89 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

◆  
**Responsive to the amendment filed July 6<sup>th</sup>, 2004.**

**This action is non-final.**

**Claims 1, 3-47, 49-80, 82-103, and 112-114 are pending.**

◆  
***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-12, 15-21, 41, 44-47, 49-56, 58-72, 78-80, 82-88, 91-98, 100-101 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Webb* (6,336,860) in view of *Paulsen* (6,609,978).

Regarding claims **1, 41, 47, 49, and 64**, Webb teaches a method of operating a gaming machine, that comprises the steps of: providing a first game of chance (1<sup>st</sup> row in multi-hand poker or a symbol color} which concludes in a final outcome; providing a second game of chance {2<sup>nd</sup> row in multi-hand poker or a symbol shape} which has the potential on every play for achieving a prize award; placing a wager; operating said first game of chance; operating said second game of chance in conjunction with the first game of chance {both 1<sup>st</sup> and 2<sup>nd</sup> rows are played at the same time- concurrently- and the game characters in the character embodiment are shown with both their shape and color in Webb}; awarding any prize achieved in the second game of chance ( Col 6:49-7:67). While Webb teaches the feature of prize awards, Webb lacks the explicit teaching of the prizes being non-monetary. In an analogous electronic slot gaming machine that includes slot games and simulated card games, Paulsen teaches the feature of prize awards that are only non-monetary (abstract; Fig. 1; col. 3, lines 27-30; col. 1, lines 33-39 and lines 50-57; col. 2, lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the non-monetary prize feature, as taught by Paulsen, as the prize award feature in the second game of Webb to provide more desirable gaming opportunities for players that are more attracted to games with non-monetary prizes or alternatively for game operators in jurisdictions that might restrict the prizes to non-monetary prizes, according to the gaming rules of those jurisdiction.

Regarding claims **3-6, and 58-61**, Webb and Paulsen teach all the limitations of the claims as discussed above. Paulsen further teaches that the prizes could be

tangible goods and services (col. 5, lines 23-32). Paulsen is silent regarding the explicit disclosure of point values. However, it is well known in the art to award players points values that are credits that can be redeemed during a next play of the game or at various other times (in the form of tickets, vouchers, etc.). Further, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate prize points in Paulsen to further enhance the player's gaming experience through allowing the convenient management of their winnings until they wish to receive them or have concluded play..

Regarding claims **7-9, 12, and 15-19**, Webb and Paulsen teach all the limitations of the claims as discussed above. Webb further teaches a plurality of different card/symbol indicia {interpreted as prize indicia by the examiner because combinations of the card/symbol indicia determine the prize (payout) awarded to the player} for the second game of chance, a preset number of card indicia {five cards} being displayed in the course of the second game through a random selection, and said prize award is achieved through a predetermined association of the card indicia {prizes or payouts are awarded in Webb according to a predetermined combination of the card indicia} (abstract; col. 4, lines 35-55). Further, Paulsen teaches a plurality of non-monetary prize awards (abstract).

Regarding claims **10-11, 50-56, and 65-71**, Webb and Paulsen teach all the limitations of the claims as discussed above. Webb further teaches that the indicia of the first and second game of chance are displayed in a like number to each other {five indicia are displayed for both the 1<sup>st</sup> and 2<sup>nd</sup> hand} in at least column 7, lines 36-48.

Regarding claims **20, 62, and 72**, Webb and Paulsen teach all the limitations of the claims as discussed above. While Webb teaches a third game (Col 7:35-8:12) {a third hand or equivalent row}, Webb is silent regarding the explicit disclosure of this game as a bonus game. Webb also lacks the explicit disclosure of the bonus game being won as one of the prizes from the second game. However, the examiner asserts that bonus games are well known in the art. Further, it is well known in the art to "award" players with a bonus game for achieving certain ideal outcomes in a base game. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ these features in Webb and Paulsen to provide increased popularity for continued play of the gaming device; thereby providing increased profits to the gaming establishment.

Regarding claims **21, and 63**, Webb and Paulsen teach all the limitations of the claims as discussed above. The references are silent regarding the use of a player tracking system. However, the examiner takes notice that it is well known in the art to employ player tracking systems as a means of tracking players and awarding valuable players {those that frequent the gaming establishment and/or spend large sums of money on the gaming machines}. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include player tracking in Webb and Paulsen as an incentive for a player to play the second game {second hand of Webb} to increase play at the gaming machine.

Regarding claims **44-46**, Webb and Paulsen teach all the limitations of the claims as discussed above. Paulsen further teaches the delivery of coupons, vouchers or

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other entitlement papers for the prizes (col. 5, lines 28-32). Paulsen is silent regarding the use of a printer to deliver the coupons, etc. It is well known in gaming arts to print out slips with gaming credits for players to redeem at a cashier's station or other place within the gaming establishment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of a printer in Paulsen to provide an easy, convenient means for players to receive game credits.

Regarding claims **78-80, 82-88, 91-98, 100-101**, and **103**, Webb and Paulsen teach all the limitations of the claims as explained in detail in reference to similar claims, above.

Claim **102** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Webb** (6,336,860) in view of **Paulsen** (6,609,978), further in view of **Hughes-Baird** et al (6,468,156).

Webb and Paulsen teach all the limitations of the claims as discussed above. The references are silent regarding a bonus payout table. However, in an analogous gaming device, Hughes-Baird teaches a bonus pay schedule Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ a bonus pay schedule, as taught by Hughes-Baird in Webb and Paulsen to increase the player's chances of winning additional money thereby increasing play at the gaming device.

Claims **14, 36-39, 57, 73-77, 90, 99** and **114** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Webb** (6,336,860) in view of **Paulsen** (6,609,978), further in view of **Yoseloff et al** (6,311,976).

Webb and Paulsen teach all the limitations of the claims as discussed above. While Webb and Paulsen teach slot gaming devices, the references lack the explicit disclosure of the devices having a reel display. In an analogous slot gaming device, Yoseloff teaches the use of reel slot machines in a video gaming environment (col. 1,lines 40-48). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include reels in Webb and Paulsen to make the game more realistic and exciting by simulating the reels of original, mechanical slot machines.

Claims **22, 40, and 42-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Webb** (6,336,860) in view of **Paulsen** (6,609,978), further in view of **Meekins et al** (6,685,563).

Regarding claim **22**, Webb and Paulsen teach all the limitations of the claim as discussed above. While Webb teaches the feature of placing a wager for a first and second game {1<sup>st</sup> and 2<sup>nd</sup> hands} (abstract, Col 5:10-18, Col 6:14-26), Webb is silent regarding the feature of the wager for the second game being greater in value than the wager for the first game. In an analogous gaming device, Meekins teaches the feature of a greater threshold wager being required for the player to play a second game {bonus game} than that required to play the first game (col. 2,lines 4-10 and lines 41-50). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to include this feature of Meekins in the gaming devices of Webb and Paulsen to increase revenues to the casinos and wagering establishments.

Regarding claims **40** and **42**, Webb and Paulsen teach all the limitations of the claims as discussed above. While Webb teaches the play of the first and second game with a wager for each, Webb is silent regarding play of the second game if the wager is of a preset amount. Meekins teaches this feature as discussed above. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Meekins in the gaming devices of Webb and Paulsen to increase revenues to the casinos and wagering establishments.

Regarding claim **43**, Webb, Paulsen and Meekins teach all the limitations of the claims as discussed above. Paulsen further includes the use of a card to place a wager (Fig. 4B, #414e; col. 3,lines 19-21). It would have been obvious to a person of ordinary skill in the art at the time of the invention for further enhance Paulsen to include requiring the player to place a preset wager on the card to promote the use of a card as the means for wagering; this would decrease the amount of maintenance needed for the machine for refilling and unloading coins; thereby making it easier for the gaming establishment to maintain the machines. Further, the use of cards makes it more convenient for the establishment to provide player tracking and award comps to frequent players, which is a well known feature in the gaming art.

#### **Allowable Subject Matter**

Claims **112-113** are allowed.

Claims 13, 23-35, 56, and 89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for the indication of allowable subject matter can be found in the previous office action (paper #9, 12/3/03), which is incorporated herein by reference.

### ***Response to Arguments***

Applicant's arguments, see applicant's remarks filed July 6<sup>th</sup>, 2004, with respect to the rejection(s) of claim(s) 78 and 96 under Moody (6,007,066) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Webb (6,336,860) which incorporates the previously presented features of moody in addition to the teaching of gaming outcomes irrespective of one another.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (571)-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM



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